
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Atty. Docket No: **0016-00011 US**

Tanay *et al.*

Art Unit: 2685

U.S. Patent No.: 6,487,414

Examiner: Urban, Edward F.

Issued: November 26, 2002

Confirmation No.: 6487

For: **SYSTEM AND METHOD FOR FREQUENCY
PLANNING IN WIRELESS COMMUNICATION
NETWORKS**

Customer No: **94979**
PATENT TRADEMARK OFFICE

**PETITION TO REVIVE A PATENT FOR UNAVOIDABLY LATE PAYMENT OF
MAINTENANCE FEE UNDER 37 CFR § 1.138(b)**

MS Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Patent Owner makes the following showing of the evidence of the facts leading to the unavoidably late payment of the maintenance fee being paid herewith:

1) The above-noted application became abandoned for failure to pay a timely and proper maintenance fee due on May 26, 2010, and lapsed on or about November 26, 2010. Despite reasonable efforts under the circumstances to track the maintenance fee due dates, the above patent was unavoidably abandoned. On information and belief, the original owner of the patent, Schema Ltd., of Tel Aviv, Israel, used Israeli Counsel Sanford Colb law offices ("Colb Office") whose counterpart US associated original attorneys of record were Brown Raysman Millstein Felder & Steiner LLP. Brown Raysman Millstein Felder & Steiner LLP, merged effective December 1, 2006, with Thelen Reid & Priest LLP, to form Thelen Reid Brown Raysman & Steiner LLP, which through a series of failed acquisitions, responsibility appears to have been ultimately assigned to

Nixon Peabody.¹ On information and belief, each of the successive US correspondent firms was responsible for tracking maintenance fee deadlines associated with the patent, and to communicate them to Colb Office, which was in turn, to communicate the deadlines to Schema Ltd. On information and belief, Schema did not receive a reminder of those deadlines. At all times, the patent owner Schema has intended to keep its patent in force, and intended to pay its fees timely. On information and belief, the maintenance fee was unavoidably not paid, despite commercially reasonable efforts to track the dates by the Colb Office, and counsel of record, to ensure such fees were timely paid. On information and belief, due at least in part to a typographical error in the correspondence address on the USPTO website, listing Nixon Peabody LLP, P.O. Box 60610, Palo Alto [sic], CA 94306, which should have noted 2 Palo Alto Square, 3000 El Camino Real, Suite 500, Palo Alto, CA 94306, or the post office box in Palo Alto, CA, and based on information and belief, any communication from the USPTO attempting to notify the patent owner of the failure to pay the maintenance fee, was also unintentionally and unavoidably not received by the Patent Owner, as there appears there was no communication of the failure to pay the maintenance fee received by the owner, and the maintenance fee was unavoidably not paid, despite commercially reasonable efforts to track the dates and to ensure such fees were timely paid.

2) On information and belief, the series of US law firms of record were responsible to track maintenance fee deadlines for the patent owner, as was the custom of patent owner Schema Ltd.. The series of US law firms responsible for tracking such deadlines, on information and belief, used commercially reasonable systems including docketing systems, to track the US maintenance fee

¹ Beginning in 2007, the firm Thelen Reid Brown Raysman & Steiner LLP experienced trouble integrating with Brown Raysman. By autumn 2008, the firm saw the departures of the three "name partners" from the Brown Raysman Steiner side. The firm shortened its name to Thelen LLP in August 2008. The firm lost almost 200 attorneys between merger and the October 2008 dissolution vote, including many important rainmakers and practice groups, who moved to various firms. In July 2008, the firm internally announced its intention to seek another merger partner to boost its headcount and stem the tide of partner defections. After merger discussions with East Coast firm Nixon Peabody failed, the firm began looking to shed practice groups and offices under the threat of dissolution. On October 28, 2008, the firm's partnership council recommended that the firm's partnership dissolve the firm. The firm's line of credit was cut off due to many partners departing the firm. In early November between 60 and 90 attorneys, from offices in San Francisco, Silicon Valley, New York, Los Angeles, Washington, D.C., and Shanghai, were reportedly hired by Nixon Peabody. On September 17, 2009, Thelen filed for Chapter 7 bankruptcy in the Southern District of New York, after the firm's only secured creditor, Citibank, was also no longer willing to advance funds for the cost of collection and to wind down operations.[Source: http://en.wikipedia.org/wiki/Thelen_LLP]

deadlines for tracking deadlines for payment of US maintenance fees, and such firms, all large US law firms, on information and belief, used industry standard electronic docketing databases from various well known vendors, in use by each respective firm, using industry reasonable efforts to track these deadlines. On information and belief, such deadlines were tracked and would normally result in reminders being sent to the patent owner Schema Ltd. to authorize the processing of payment of such fees. On information and belief, no reminders were received by the patent owner Schema Ltd. Further, despite the reasonable efforts to track the deadlines by the patent owner's series of law firms, the fee due November 26, 2010 was not paid. On information and belief, upon lapse of the patent for failure to pay the fee by the original deadline, a communication was presumably sent by the USPTO to the correspondence address of record, which unavoidably included a typographic error, noting "Palo Alo" rather than Palo *Alto*, and on information and belief, such lapse, and opportunity to revive, was unavoidably never communicated to the patent owner. Throughout the time period of the patent's term, including the time period beginning when the fee was not paid, throughout the time the fee the fee was not paid, through the time when it was recognized for the first time that the fee was not paid on or about September 2012, and up through the current time when the petition is being filed, the owner has not intended to abandon the patent.

3) On information and belief, in addition to the US based law firms responsible for tracking the deadlines, Israeli counsel Sanford Colb also tracked the deadlines for Schema Ltd. and despite reasonable and diligent efforts to track the maintenance fee deadlines, the fees were not paid timely, and the patent was found to be abandoned on or about September 4 of 2012.

4) On or about February 23, 2012, Schema Ltd. ("Schema") was acquired by TEOCO Ltd. ("TEOCO"). During investigation, on or about September of 2012, of updating the ownership status of the patent owner's assets, upon the acquisition of Schema by TEOCO, it was discovered that the maintenance fee for the US Patent had not been paid, and that the patent had lapsed both unavoidably and unintentionally for failure to pay the maintenance fee. Indeed throughout the acquisition process, the patent was presented by Schema to acquirer TEOCO Ltd., and the patent was believed by Schema to be valid, in force, unexpired, and enforceable, but unbeknownst to both patent owner and acquirer, the patent had expired/lapsed, unbeknownst to the patent owner,

unintentionally and unavoidably, due to failure to timely pay the maintenance fee for the reasons detailed above.

5) On or about September 4, 2012, on information and belief, the Israeli law firm of Sanford T. Colb & Co., Intellectual Property Law office ("Colb Office"), determined that the US patent had been unintentionally and unavoidably been abandoned. On September 5, 2012, representatives of the Colb Office contacted the law offices of Sughrue Mion PLLC, www.Sughrue.com, a US intellectual property law firm to determine options to revive the unintentionally and unavoidably abandoned patent. On September 6, 2012, it was determined by Colb Office that the patent could be revived for unintentional abandonment no later than December 27, 2012 [sic]. On information and belief, Colb Office failed to determine the correct deadline for reviving the unintentionally abandoned patent. Unfortunately, on information and belief, unbeknownst to all those involved at the time, the correct deadline was November 26, 2012, and the incorrectly calculated deadline of December 27, 2012 was then improperly docketed as a deadline to seek revival for unavoidable and unintentional delay by the counsel Colb office and its correspondent US counsel. The incorrect date of December 27, 2012 was unintentionally communicated by the Colb Office to the Israeli office of TEOCO LTD September 6, 2012.

6) Following the current patent owner TEOCO LTD.'s management decision to start the process of reviving the US Patent in approximately September 2012, on information and belief, TEOCO LTD. instructed the Colb Office on or about November 6, 2012, to prepare and file the above mentioned petition to revive for unintentional abandonment by failure to timely pay maintenance fee for patent.

7) On information and belief, based on a misunderstanding of the incorrectly calculated December 27, 2012 deadline to file a petition to revive for unintentional abandonment, the Colb Office unavoidably failed to prepare and submit the petition to revive timely, via its US correspondent firm Sughrue Mion, despite numerous reminders and requests of TEOCO personnel to the Colb Office to pursue revival.

8) On December 4, 2012, following various reminders from TEOCO, on information and belief, Colb Office sent TEOCO an e-mail confirming that they were dealing with the matter of filing the petition by the due date of December 27, 2012.

9) Notwithstanding the e-mail of (8), and additional reminders from TEOCO, on December 19, 2012, owner TEOCO discovered that the petition had not yet been filed by Colb Office, due to their technical errors. The Colb office then requested that their US associate William H. Mandir of Sughrue Mion PLLC, by a December 19, 2012 email communication, file the petition urgently.

10) On the following day, December 20, 2012, Colb Office again incorrectly confirmed that the due date was indeed December 27, 2012. However, later that day, the US Associate Sughrue Mion PLLC sent an e-mail stating that the petition could not be filed, since the due date was actually November 26, 2012. Colb Office later provided the following clarification: “the PTO’s PAIR transaction history listing of the date that the patent expired has a clerical error – December 27, 2010 is listed instead of November 27, 2010. (The maintenance fees to pay screen correctly lists the date that the window closes at 11/26/2010.)” Thus, to do the errors by counsel in correctly calculating the due date to revive for unintentional abandonment, a petition to revive was not timely filed.

11) Upon further requests by TEOCO to Advisor Sanford Colb from Colb office for explanations, the Colb office communicated that the Colb Office resigned from the case, on or about December 2012.

12) On or about December 24, 2012, TEOCO communicated to the undersigned counsel, Ralph P. Albrecht of Albrecht Tousi & Farnum PLLC dba ATFirm, and requested a thorough review of the facts and preparation of a petition to revive under the above circumstances, as soon as possible. Despite the holiday season, the undersigned reviewed the facts and confirmed on December 25, 2012, that the date to revive for unintentionally delayed payment had run, and that the facts supporting unavoidable abandonment would have to be researched to determine whether the delayed payment of the maintenance fees for unavoidable delay could be demonstrated based on the facts of the case. From December 25, 2012, through January 25, 2013, despite the holiday season, the undersigned has gathered the above facts from the various international law firms involved in the unavoidably delayed payment, and provides the above, clear showing supporting this petition to revive the above patent for unavoidable abandonment.

As enumerated above, Patent Owner petitions to revive the above referenced US Patent 6,487,414 for unavoidably delayed payment of maintenance fee leading to the unavoidable abandonment, despite reasonable efforts undertaken by the Patent Owner(s) to have the deadlines tracked by Patent Counsel using industry commercially reasonable efforts using various docketing systems, and including electronic docketing systems of the respective firms responsible for tracking such deadlines, as detailed above. Despite such commercially reasonable efforts, the fees failed to be paid, unintentionally and unavoidably, from the time of failure of payment in late 2010, throughout the time including discovery of the error in September of 2012, and throughout the time up until the filing of this petition to revive in January 2013.

As noted in detail above, immediately upon learning of the failure to pay the maintenance fee, and the associated abandonment of the patent, the Patent Owner immediately sought with diligence to engage legal counsel to seek revival of this application, with all due urgency. The delay in paying the fees was unintentional and unavoidable from the beginning, and throughout the entire time of the application's abandonment, including upon discovery of the abandonment, and up until the filing of this petition.

The abandonment was both 1) unavoidable and 2) unintentional, however, at the present time only the former may be argued, despite diligent efforts by the Patent Owner to seek revival for both the unintentional and unavoidable late payment, and hereby authorize any such petition fees to be paid, immediately, via the undersigned's credit card, provided with this submission. Applicants and owner hereby petition to seek revival for unavoidable abandonment (and/or unintentional delay, if possible in this situation). Fees for such petition are included herewith.

Applicant respectfully submits that 37 C.F.R. § 1.378, including a section entitled, "Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent" requires:

"(a) The Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been **unavoidable** (paragraph (b) of this section) or unintentional (paragraph (c) of this section) and if the **surcharge** required by § 1.20 (i) is paid as a condition of accepting payment of the maintenance fee. If the Director accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41 (c)(2).

(b) Any **petition to accept an unavoidably delayed payment** of a maintenance fee filed under paragraph (a) of this section must include:

- (1) The **required maintenance fee** set forth in § 1.20 (e) through (g);
- (2) The **surcharge** set forth in § 1.20 (i)(1); and

(3) A **showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.**

...

(d) Any petition under this section must be **signed by an attorney** or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest. ”

Such a showing above of (3) of section (b) is included herewith, as well as the amount of the maintenance fee of \$2,900.00, and the surcharge under 1.20(i)(1) of \$700.00, for a total of \$3,600.00. The showing of (3) appears above, and clearly shows how the entire delay in filing the required reply was unavoidable. The date of discovery of the unintentional and unavoidable abandonment was on or about September 2012, and diligence was undertaken to investigate and pursue the timely revival of this patent by preparation of the above petition to revive for unavoidable abandonment due to delayed payment of the hereby submitted maintenance fee.

It is respectfully submitted that all items in 37 CFR § 1.138(b) have been complied with, and notably that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.138(b) was unintentional and unavoidable. Accordingly, it is respectfully requested that the above noted patent application be revived at earliest convenience, and that any and all USPTO submissions be entered.

If there are any questions regarding this Petition to Revive, or if it is deemed that personal communication will expedite the matter, kindly do not hesitate to contact the undersigned.

Dated: January 29, 2013

Respectfully submitted,

By: /s/ ralph p. albrecht/

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